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22428	7590	03/18/2010	EXAMINER	
FOLEY AND LARDNER LLP			MOWLA, GOLAM	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,943	Applicant(s) AJAYAN ET AL.
	Examiner GOLAM MOWLA	Art Unit 1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 December 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-42 is/are pending in the application.
 4a) Of the above claim(s) 6,8,13,20 and 24-42 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-5,7,9-12,14-19 and 21-23 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 09 June 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 06/09/2005 and 03/05/2007.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 24-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/15/2009.
2. Applicant's election with traverse of species A₁, B₁, C₁ and D₁ in the reply filed on 12/15/2009 is acknowledged. The traversal is on the ground(s) that these species correspond to dependent claims which depend from claim 1, and therefore, these species are thus linked by the general inventive concept recited in independent claim 1 from which these dependent claims depend. This is not found persuasive because when each of these species are linked to claim 1, they do not form a single general inventive concept under PCT Rule 13.1, each species correspond to a different inventive concept. For example, Species A₁ corresponds to a solar cell, whereas the species A₂ corresponds to a photodetector which is different than a solar cell. Similar reasoning applies to other species.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 6, 8, 13 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/15/2009.

4. Although Applicant states that claims correspond to non-elected species D₂, Examiner notes that claim 19 corresponds to non-elected species D₂, and therefore, withdrawn from consideration.

Priority

5. Acknowledgement is made of Applicant's claim for domestic priority of Provisional Application No. 60/431,948, filed on 12/09/2002, under 35 U.S.C. 119(e), which papers have been placed of record in the file.

However, the provisional application does not have support for dependent claims 3-4, 7, 9-12, 14-18, 20-23. Therefore, the **effective filing date** of pending claims 3-4, 7, 9-12, 14-18, 20-23 is the international filing date (12/09/2003).

Claim Objections

6. Claim 21 is objected to because of the following informalities: "a flexible threat" is recited in line 2, although "a flexible thread" is intended. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 7, 9-10, 17 and 21-22 rejected under 35 U.S.C. 102(b) as being anticipated by Smalley et al. (WO 98/39250). Supporting evidence is provided by Garg

et al., ("Effect of chemical functionalization on the mechanical properties of carbon nanotubes," *Chem. Phys. Lett.*, October 16, 1998, 295, 273-278).

Regarding claims 1, 4-5, 9-10 and 22, Smalley teaches an organic photovoltaic conversion device such as a solar cell (page 50, lines 14-30) comprising a polymer matrix material having carbon nanotubes well dispersed therein (page 6, lines 3-5; page 30, line 18-page 33, line 20; page 35, line 1-page 37, line 27; page 62, line 3 – page 63, line 3; claims 117-122) and organic dye molecules (page 50, lines 14-30) are attached to defect sites on the carbon nanotubes (the ends of the nanotubes are chemically functionalized/derivatized and therefore forms defect sites at the ends (page 30, line 18-page 33, line 20; page 35, line 1-page 37, line 27), and the dyes are bonded to the ends, i.e., defect sites (page 50, lines 22-24)) (see Garg, page 227, right column, which discloses the functionalization forms defects on the walls of CNTs). The reference further teaches that the polymer matrix material is selected from polyamides, polycarbonates etc. (page 62, lines 23 – page 63, line 3).

Regarding claim 2, Smalley further discloses the photovoltaic organic molecules are adapted to generate a photocurrent upon absorbing radiation (page 50, lines 22-24). Moreover, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to perform so (see MPEP §2144).

Regarding claim 3, Smalley further discloses that the photovoltaic organic molecules are bonded to the defect sites on the carbon nanotubes such that the absorbed radiation provides excitation transfer from the photovoltaic organic molecules

to the carbon nanotubes (page 30, line 18-page 33, line 20; page 35, line 1-page 37, line 27; page 50, lines 14-30). With respect to the process step "chemisorbed", the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" (MPEP §2113; *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964,966 (Fed. Cir. 1985)).

Regarding claim 7, Smalley further discloses that the defect sites on the carbon nanotubes comprise a carboxyl group or a C1-6 alkyl group (page 32, lines 10-14).

Regarding claims 17-18, Smalley further discloses that the device comprises two electrodes (#11 and #15 as shown in fig. 1 of U.S. Patent 5,084,365 to Gratzel et al., which is incorporated in Smalley in its entirety at page 50, lines 15-16) of which at least one is transparent to radiation (4:19-22 of Gratzel).

Regarding claim 21, Smalley further discloses that the matrix material comprises a flexible thin film (polymer such as polyamide which is flexible) (page 62, lines 23 – page 63, line 3) on a substrate (substrate of Gratzel, 4:19-24), and the overall stiffness of the device is determined by the stiffness of the substrate (see 4:19-24 of Gratzel which discloses the substrate can be made of glass or plastic, and therefore the stiffness, i.e. rigidity/flexibility, of the device depends on the material used for the substrate).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smalley as applied to claim 1 above, and further in view of Gopidas et al. ("Photophysics and photochemistry of phenoisrafranin dye in aqueous and acetonitrile solutions," *Photochem. Photobiol. A: Chem.*, 1989, 48, 291-301).

Regarding claims 11 and 12, Applicant is directed above for complete discussion of Smalley with respect to claim 4 above, which is incorporated herein. The reference further discloses that the dye comprises a photoactive dye such as cis-(bisthiacyanato bis (4,4'-dicarboxy-2-2'-bipyridine Ru (II) (page 50, lines 22-24). However, the reference is silent as to whether the photoactive dye comprises phenoisrafranin (PSF).

Gopidas teaches that phenoisrafranin (PSF) absorbs strongly in the visible region and such dyes have important application in extending the absorptive range of large

bandgap semiconductors and improving the performance of the cell (see Introduction, page 291).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the PSF dye in the solar cell of Smalley to enhance the absorption of lights in the visible region, as taught by Gopidas, and as also the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (MPEP § 2144.07).

12. Claims 14-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smalley as applied to claims 1 and 5 above, and further in view of Shiratsuchi et al. (US 6084176).

Regarding claims 14-15, Applicant is directed above for complete discussion of Smalley with respect to claim 5 above, which is incorporated herein. Smalley further discloses a charge transporting layer (electrolyte layer of Gratzel) is located in contact with the matrix material. However, the reference is silent as to whether the charge transporting layer is at least one of a p and n type charge transporting layers.

Shiratsuchi discloses a solar cell (fig. 1) wherein the charge transporting layer (5) comprises p-type compound such as hydrazone compound (col. 14, lines 7-23) to transfer holes generated in the photoactive layer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the charge transporting layer of Shiratsuchi in the

device of Smalley to transfer holes generated in the photoactive layer, as taught by Shiratsuchi.

Regarding claims 16 and 18, Applicant is directed above for complete discussion of Smalley with respect to claim 1 above, which is incorporated herein. However, the reference is silent as to different types of photovoltaic organic molecules attached to the carbon nanotubes, wherein the different types of molecules have a peak sensitivity to different radiation wavelengths.

Shiratsuchi discloses a mixture of dye allows the wavelength range of solar cell as broad as possible (12:58-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a mixture of dye in the device of Smalley in order to make the wavelength range of solar cell as broad as possible as taught by Shiratsuchi.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smalley as applied to claim 1 above, and further in view of Bulovic et al. (US 6352777).

Applicant is directed above for complete discussion of Smalley with respect to claim 5 above, which is incorporated herein. The reference is silent as to whether the solar cell comprises a bilayer cell containing a heterojunction of two charge generating layers each containing a different type of organic photovoltaic molecule.

Bulovic discloses a solar cell (see embodiment of figure 8, 4:36-54 and 18:28-57) comprising a plurality of stacked photosensitive subcells, each subcell comprising a bilayer cell containing a heterojunction of two charge generating layers each containing a different type of organic photovoltaic molecule (one layer comprises hole transport

layer, and other comprises electron transport layer, and forms heterojunction as the interface).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the bilayer cell of Bulovic in the device of Smalley to allow for device with plurality of stacked photosensitive subcells such that more lights can be harvested.

14. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smalley as applied to claim 1 above, and further in view of Homma (US 4611914).

Applicant is directed above for complete discussion of Smalley with respect to claim 4 above, which is incorporated herein. The reference is silent as to whether the device is formed on an outer surface of a space suit or a space ship.

Homma discloses a space suit or space ship (satellite) and further discloses that solar cells are formed over the outer surface of the satellite body to supply sufficient electric power generated by the solar cell (see figures, 1:13-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the device of Smalley over the space suit/ship to supply sufficient electric power generated by the solar cell, as taught by Homma. Since the device is formed on the outer surface of the space suit/ship, the matrix material must also be formed on the outer surface of the space suit/ship as the matrix material is part of the solar cell.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-5, 7, 9-12, 14-19 and 21-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10/537,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the copending application encompass the limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Correspondence/Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GOLAM MOWLA whose telephone number is (571) 270-5268. The examiner can normally be reached on M-Th, 0800-1830 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXA NECKEL can be reached on (571) 272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 1795

/Alexa D. Neckel/
Supervisory Patent Examiner, Art Unit 1795